

By Facsimile

**REMARKS**

This communication is considered fully responsive to the Office Action mailed September 21, 2005. Claims 1-56 and 65-105 were examined with claims 1, 27, 29-36, 39-41, 44-47, 50-56, 66-89 and 92-101 standing rejected and claims 28, 37, 38, 42, 43, 48, 49, 65, 90 and 91 objected to. No claims are hereby amended. No claims are cancelled. No claims are hereby added. Reexamination and reconsideration are respectfully requested.

**Election/Restrictions**

Applicants hereby reconfirm their prior election of the invention(s) of Group I.

**Specification Objection**

An objection has apparently been made to the specification inasmuch as the Examiner did not check it "to the extent necessary to determine the presence of all possible minor errors." As there is no specific objection, Applicants respectfully request withdrawal of this objection.

**Claim Rejections – 35 USC §102**

Claims 1-6, 21-27, 39-40, 66-70, 73-75, and 85-85 (sic?, means 82-85?) stand rejected under 35 USC §102(b) as being purportedly anticipated by the U.S. Patent to Andelman, No. 6,127,474 (hereafter referred to as "Andelman"). Applicants respectfully traverse this rejection.

Applicants respectfully submit that Andelman teaches devices and methods different from the characterizations of the Office Action of September 21, 2005. For a first example, nowhere in Andelman is there a teaching of a "self-supporting film." This concept is not explicitly nor equivalently taught in Andelman. More importantly, Andelman rather teaches the relative weakness of and the therein requirement for more than one binder and carbon particles. This is contrary to the minimally claimed elements here. Indeed, the passage referred to in the Office Action (col. 5, lines 20-40) requires a "ternary binder system" (Andelman, col. 5, lines 23-24), which is by definition more than

By Facsimile

a minimal binder with carbon particles. Thus, a self-supporting film formed of a binder and carbon particles is not taught by Andelman.

Each of Applicants present claims 1-6, 21-27, 40, 66-70, 73-75, and 85 (as well as those claims 82-84 from which claim 85 depends) have the requirement for a "self supporting film" and thus are not identically found within Andelman. Note that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); and see, MPEP 2131.

Claim 39 does not require a "self supporting" film; however, as mentioned above, Andelman requires more than one binder, which is more than what is identically within claim 39 (which requires merely a "binder and carbon particles"), and thus Andelman also does not identically teach the elements of and thereby does not anticipate claim 39.

Applicants therefore respectfully request withdrawal of this rejection of claims 1-6, 21-27, 39, 40, 66-70, 73-75, and 85 (as well as those claims 82-84).

Note, this failure of Andelman is sufficient to obviate, traverse or otherwise overcome the alleged rejection regardless any of the other assertions of the Office Action of September 21, 2006, i.e., those on page 2 through the first five lines of page 5, which are thus also obviated/traversed hereby.

Claims 1-5, 8-13, 19-20, 27, 29, 35, 39, 40-41, 45-46, 66-71, 73-75, 81-89, 92, 94-95, 10181 (sic), 86-88, 92 and 95 (sic, these last five (5) claims having been repeated) stand rejected under 35 USC §102(b) as being purportedly anticipated by the EP Patent to Sato, et al., No. BP 1,126,536 (hereafter referred to as "Sato"). Applicants respectfully traverse this rejection.

Applicants respectfully submit that Sato fails to teach the limitations of any of these claims. In particular, as taught in Sato, a solvent is used in the manufacture of the devices thereof. This is contrary to the definition of the elements in Applicants' claims which all require a "dry" binder and "dry" carbon particles. See e.g., paragraph 0041 of Sato, which requires that:

By Facsimile

An example of the manufacturing method used to produce the multi-layer electrode structure is shown in FIG. 3. To manufacture the multi-layer electrode structure 1, an electrode material 11, a powdered electrically-conducting substance 14, a binder 17, and a solvent 19 are mixed together in a mixer 3 to obtain a slurry constituting the mixed material 31.

(Emphasis added.)

Applicants' always "dry" materials are thus not explicitly taught by Sato and are moreover thereby not anticipated by Sato. This rejection has thus been obviated/traversed, and can be withdrawn. Applicants thus respectfully request withdrawal of the rejection of claims 1-5, 8-13, 19-20, 27, 29, 35, 39, 40-41, 45-46, 66-71, 73-75, 81-89, 92, 94-95, 10181 (sic), 86-88, 92 and 95 (last 5 repeated) over Sato.

Note, this failure of Sato is sufficient to overcome the alleged rejection regardless any of the other assertions of the Office Action of September 21, 2006, i.e., those on page 6 through page 10, which are thus obviated hereby.

Consequently, Applicants respectfully request withdrawal of the anticipation rejections on either or both of Andelman and Sato, and further request a notation of the allowability of these claims thereover.

#### **Claim Rejections – 35 USC §103**

Claims 7, 36, 44 and 93 stand rejected under 35 USC §103(a) as being purportedly rendered obvious by Sato. The Applicants respectfully traverse this rejection.

This rejection is made first on the basis that Sato allegedly teaches the basic elements of these claims 7, 36, 44 and 93 as they incorporate the elements of the respective base independent claims from which these claims depend; however, pursuant to section 102 (as addressed above), Sato fails to teach the "dry" requirements of all of these claims. Moreover, here as before, there is no cited support for the "dry" requirements, and as such this conclusory allegation cannot sustain a rejection under either section 102 or 103. Thus, Sato fails to render these claims obvious regardless the additional allegations of pages 11 and 12.

By Facsimile

Note moreover, that a "mere change in size" is not sufficient by itself to be determined to be "within the level of ordinary skill in the art." *In re Rose*, as cited in the Office Action (page 11, last line) is inapposite, and is not applicable here. MPEP 2144.04 in fact states that as to a change of size, and citing *In re Rose*, can only be used when "the facts in a prior legal decision are sufficiently similar to those in an application under examination," which is not the case, nor was it even asserted to be the case here. Similarly, MPEP 2144.05 and *In re Aller* (Office Action page 12, line 6), do not stand for a *per se* determination that an optimization of ranges is always obvious. The Examiner must demonstrate this would necessarily be true here due to the facts here. This was not even asserted here and is thus improper and must be withdrawn.

This rejection is thus obviated/traversed and can be withdrawn. Applicants respectfully request that it be withdrawn.

Claims 14-18, 30-34, 37, 47, 50-56 and 72 stand rejected under 35 USC §103(a) as being purportedly rendered obvious by the combination of Sato and Yoshida, et al. (US Patent No. 5,150,283). The Applicants respectfully traverse these rejections.

As a primary point, as addressed above, Sato fails to teach "dry" materials as required by all of the rejected claims. And, Yoshida is not cited to cure this failure. Thus, the combination of Sato and Yoshida fail to present all of the elements of these claims, and this combination thus fails to render obvious these claims. Moreover, Sato and Yoshida fail to render these claims obvious regardless the additional allegations of pages 12 to page 16. Applicants therefore respectfully request withdrawal of these rejections.

Claims 76-79 and 96-99 stand rejected under 35 USC §103(a) as being purportedly rendered obvious by the combination of Sato and Evans (US Patent No. 4,992,910). The Applicants respectfully traverse these rejections.

As before, Sato fails to teach "dry" materials as required by all of the rejected claims. And, Evans is not cited to cure this failure. Thus, the combination of Sato and Evans fail to present all of the elements of these claims, and this combination thus fails to render obvious these claims. Moreover, Sato and Evans fail to render these claims obvious regardless the additional allegations of pages 16 and 17. Applicants therefore respectfully request withdrawal of these rejections.

By Facsimile

Claim 80 stands rejected under 35 USC §103(a) as being purportedly rendered obvious by the combination of Sato and Evans (US Patent No. 4,992,910) and further in view of Wani (US Patent No. 5,682,288). The Applicants respectfully traverse these rejections.

Here also, as addressed above, Sato fails to teach "dry" materials as required by all of the rejected claims. And, Evans and Wani are neither one cited to cure this failure. Thus, the combination of Sato and either or both of Evans and Wani fail to present all of the elements of these claims, and this combination thus fails to render obvious this claim. Moreover, Sato and Evans and Wani fail to render this claim obvious regardless the additional allegations of pages 17 and 18. Applicants therefore respectfully request withdrawal of this rejection.

Claim 100 stands rejected under 35 USC §103(a) as being purportedly rendered obvious by the combination of Sato and Saito et al. (US Patent No. 5,706,165). The Applicants respectfully traverse these rejections.

As before, Sato fails to teach "dry" materials as required by all of the rejected claims. And, Saito et al. is not cited to cure this failure. Thus, the combination of Sato and Saito fail to present all of the elements of this claim, and this combination thus fails to render obvious these claims. Moreover, Sato and Saito fail to render this claim obvious regardless the additional allegations of page 18. Applicants therefore respectfully request withdrawal of this rejection.

#### **Allowable Subject Matter**

Applicants note with appreciation the notation of the allowable subject matter of claims 28, 37-38, 42-43, 48-49, 65 and 90-91. Applicants note that claim 65 is an independent claim, and thus the Examiner's objection of it as being dependent on a rejected base claim was mistaken. Accordingly, Applicants request that the Examiner reconsider and withdraw the objection and allow claim 65. Applicants further note that due to the allowability, as described in detail hereinabove, of independent claims 27, 39 and 86 from which claims respectively depend, these claims 28, 37-38, 42-43, 48-49, 65 and 90-91 are not herein amended. Claims 28, 37-38, 42-43, 48-49, 65 and 90-91 are therefore respectfully requested to be held allowable, and consequently allowed.

By Facsimile

Applicants note moreover that they do not necessarily agree nor disagree with the statement of reasons for the indication of allowable subject matter, but, instead reserve the right to provide contrary arguments thereto as may ever be necessary throughout the life of any patent issuing hereon.

**Conclusion**

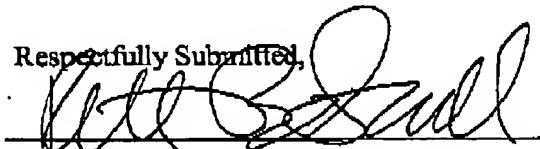
Based on the amendments and remarks herein, the Applicants respectfully request prompt issuance of a notice of allowance for claims 1-56 and 65-105 in this matter.

Dated:

January 23, 2006

By:

Respectfully Submitted,

  
Peter B. Scull  
Reg. No. 37,932  
(720) 377-0773